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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/018,515

12/13/2001

Satoshi Mekata

542-003-3

2642

4955

7590

01/21/2011

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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

01/21/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/018,515

Applicant(s)

MEKATA ET AL.

Examiner

ALTON N. PRYOR

Art Unit

1616

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22, 24, 26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 24, 26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's arguments filed 11/8/10 have been fully considered but they are not persuasive. See argument below. Previous rejections not addressed below are withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22,24,26,28 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Hiroshi (JP 11-342202; 12/14/99) and Katano et al (JP 10278982; 10/20/97). In Figure 10 of Hiroshi the aerosol device is taught. In Figure 10 reference number 1 represents the can, reference number 3 represents the cylinder, reference number 7 represents the port, reference number 4 represents the piston, reference number 4a represents the nozzle, reference number 7 represents the valve, reference number 6 represents the inner surface, reference 5 represents the first coil spring and reference number 5 represents the second coil spring. Hiroshi does not teach a spring constant to give a ratio of an injection time to a stop time set at 0.1 to 5.0. Hiroshi also does not teach the product contained in the device having 20 to 70% by weight liquefied gas or having 0.1 to 5% by weight compressed gas. However, Katano et al teach aerosol containers being used to dispense liquefied gas and compressed gas. It would have obvious to modify the invention taught by Hiroshi to include the gas types taught by Katano et al since aerosol cans be used to contain the gas types.

Response to Applicants' argument

Applicants argue that the Examiner's statement that it is within the skill of an artisan in the field to modify the prior art to arrive at the claim invention is insufficient to establish an obviousness type rejection lacking objective reasoning to combine the references. The Examiner argues that when the prior art combination of references discloses all components of a claimed invention but not the percent range of the chemical component, it is indeed within the skill of the artisan to determine the optimum amount which may fall within the claimed amount range. This is considered objective reasoning by the Examiner absent secondary considerations with respect to the claim range to overcome the rejection. Applicant points out that the claimed product comprises an effective compound. The Examiner would like to point out that JP '982 teaches the delivery of medicaments with the device. This teaching would embrace the effective compounds enumerated in instant claims. Applicants argue that cited references fail to teach or suggest that a product comprised in the device having 20 to 70% liquefied gas as recited in the claims.

Applicants direct the Examiner's attention to the specification at page 7 lines 18-27 where it states that the pressure of the product is dropped and the injection can no be conducted when the amount of compressed gas in the aerosol product is less than 0.1% by wt. and the stop time is reduced and the injection time to stop time ratio exceeds 5.0 when the amount of liquefied gas is greater than 70% by wt. of the aerosol composition. The Examiner argues that these are statements provided by the Applicants lacking a showing. The Applicants argue that they did not find any disclosure in Katano et al to address the following claim limitations not taught by Hiroshi: a) "a ratio of an injection time to stop time is set to 0.1 to 2.0, when a valve is opened, in order to obtain a sufficient yet not excessive cooling and/or massage effect on the skin" , b) "wherein the product contains 0.1 to 5% by weight of a compressed gas in aerosol composition"

or c) "the product contains 20 to 70% by weight of a liquefied gas in an aerosol composition".

The Applicants further argue that the Examiner did not indicate a location in Katano et al. where the limitations could be founded. The Examiner argues that in the Katano et al. reference at paragraph 2 is disclosed that aerosol containers can be used to dispense liquefied gas and compressed gas. This disclosure supports the fact that aerosol containers can contain liquefied gas as well as compressed gas. While it is true that Katano et al. do not teach instant specific claimed amount ranges such as 0.1 to 5% by weight compress gas and 20 to 70% by weight liquefied gas, the Examiner reiterates, in the absence of unexpected showing, that it is well within the skill of an artisan in the field to determine the optimum amounts. The Examiner further reiterates that an artisan would have been motivated to do this in order to develop the most safe and effective invention. Furthermore, the claims are drawn to a device and not to a device comprising a product. Note, claims specifically recite that the device is for application of a product to skin. This is a statement to the utility of the device. The device as claimed is not required to contain a product. Therefore, the percent gas content (20 to 70 % wt.) of the product as well as a product type (message agent, cleansing agent, etc.) carries no patentable weight when recited in a claim drawn to a device. With respect to the ratio of an injection time to stop time of 0.1 to 2.0 set forth in the claims, the Examiner argues that the injection time to stop time is determined by coil selection which makes this limitation a design choice. One skill in the art would know that coil type determines injection time to stop time and that an artisan has the liberty to choose a coil type that would yield the desired injection time to stop time. For the above reasons, the 103(a) rejection is maintained.

Claims 22,24,26,28 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Hiroshi (JP 11-342202; 12/14/99) or Monden (US 4262823; 4/21/81) or Ando (US 5881925; 3/16/99) and Katano et al (JP 10278982; 10/20/97). In Figure 10 of Hiroshi the aerosol device is taught. In Figure 10 reference number 1 represents the can, reference number 3 represents the cylinder, reference number 7 represents the port, reference number 4 represents the piston, reference number 4a represents the nozzle, reference number 7 represents the valve, reference number 6 represents the inner surface, reference 5 represents the first coil spring and reference number 5 represents the second coil spring.

In Figures 1-2 of Monden the aerosol device is taught. In Figure 1-2 reference number 6 represents the cylinder, reference number 22 represents the port, reference numbers 9 and 15 represent the piston, reference number 22 represents the nozzle, reference number 31 represents the needle, reference numbers 18 and 19 represent the inner surface, reference 24 represents the coil springs and reference number 27 represents pressure chamber.

In Figures 1-2 of Ando the aerosol device is taught. In Figure 1-12 reference number 20 represents the cylinder, reference number 22 represents the port, reference number 28 represent the piston, reference number 18 represents the nozzle, reference number 24 represents the needle, reference numbers 20h represent the inner surface, references 20m and 28a represents coil springs and reference number 30 represents pressure chamber.

Hiroshi, Monden or Ando does not teach a spring constant to give a ratio of an injection time to a stop time set at 0.1 to 5.0. Hiroshi also does not teach the product contained in the device having 20 to 70% by weight liquefied gas or having 0.1 to 5% by weight compressed gas. However, Katano et al teach aerosol containers being used to dispense liquefied gas and

compressed gas. It would have obvious to modify the invention taught by Hiroshi to include the gas types taught by Katano et al since aerosol cans be used to contain the gas types. Furthermore, the claims are drawn to a device and not to a device comprising a product. Note, claims specifically recite that the device is for application of a product to skin. This is a statement to the utility of the device. The device as claimed is not required to contain a product Therefore, the percent gas content (20 to 70 % wt.) of the product as well as a product type (message agent, cleansing agent, etc.) carries no patentable weight when recited in a claim drawn to a device. With respect to the ratio of an injection time to stop time of 0.1 to 2.0 set forth in the claims, the Examiner argues that the injection time to stop time is determined by coil selection which makes this limitation a design choice. One skill in the art would know that coil type determines injection time to stop time and that an artisan has the liberty to choose a coil type that would yield the desired injection time to stop time. For the above reasons, the 103(a) rejection is maintained.

Response to Applicants' argument

Applicant points out that the claimed product comprises an effective compound. The Examiner would like to point out that JP '982 teaches the delivery of medicaments with the device. This teaching would embrace the effective compounds enumerated in instant claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/

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Primary Examiner, Art Unit 1616